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| 10/771,835   | 02/03/2004  | Shahin I. Bina       | 767-003u                          | 9723             |
| 39600  | 7590        | 03/22/2006           |                                   |                  |
| SOFER & HAROUN LLP.<br>317 MADISON AVENUE, SUITE 910<br>NEW YORK, NY 10017 |             |                      | EXAMINER<br>STOKES, CANDICE CAPRI |                  |
|  |             |                      | ART UNIT                          | PAPER NUMBER     |
|  |             |                      | 3732                              |                  |

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/771,835

Applicant(s)

BINA ET AL.

Examiner

Candice C. Stokes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 12, 13, 16, 17 and 20 is/are rejected.
- 7) ☒ Claim(s) 5, 9-11, 14, 15, 18 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

Claims 2 and 19 are objected to because of the following informalities: in claim 2, line 5 “toot” should be “root” and in claim 19, line 1 “the device as claimed in claim 19” should be “the device as claimed in claim 18”. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1) Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown (USPN 3,620,637). Brown discloses a device (Fig. 4), said device comprising a first upper unit (18) coupled to said drill hand set (10), said first upper unit (18) being cylindrical in shape (see Fig. 4) and having a first drill shank shaft (26) therethrough. Brown also discloses said first upper unit (18) having a first threading (22) on its outside surface; a second bottom unit (20) being cylindrical in shape (see Fig. 4) and having a second drill shank shaft (27) therethrough said second bottom unit (20) having a second corresponding threading (24) on its inside surface (as shown in Fig. 4), wherein when said second bottom unit (20) is screwed onto said first upper unit (18) a jig is formed, the jig further having a set height and allowing a shank from said drill hand set (10) to pass through said first and second drill shank shafts (26,27), such that when said drill shank (48) of said drill hand set (60) is drilled into an area, said drill shank is prevented

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from drilling along its entire length into the area when the bottom of said jig contacts the top of the area. As to claim 6, Brown discloses a device (Fig. 4), said device comprising; a jig ring (20) having a drill shank opening (30), configured to rest on the top of the area to be drilled; a stem (31), coupled to said jig ring (20); and a housing (18), coupled to said drill hand set (10), said housing (18) configured to secure said stem (31) therein, such that the bottom of said jig ring (20), coupled to said stem (31), can be secured from the bottom of said housing (18), proximate to the drilling end of said drill hand set at (10) a series of varying heights.

2) Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Gibbs (USPN 6,905,486). Gibbs discloses a device (see Fig. 9) for use in an endodontic root canal, performed using a dental drill hand set, said device comprising; a root canal jig having a top (29) and bottom (13) and an adjustable height (by way of threads as shown in Fig 8), said top (29) of said root canal jig being attachable to said dental drill hand set (see Fig. 7A), configured to allow a drill shank (27) to pass therethrough, wherein said root canal jig is configured to allow a portion of said drill shank (27), less than the total height of said drill shank, to be exposed out from said bottom (13) of said root canal jig, such that when said bottom of said root canal jig contacts the top of an affected tooth (as shown in Fig. 9), said drill shank (27) is prevented from drilling any further into said affected tooth.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1) Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schenk et al (USPN 5,895,389) in view of Wilson (USPN 5,197,967). Schenk et al disclose a device (Fig. 1), said device comprising; a first upper unit (32) coupled to said drill hand set (60), said first upper unit (32) being cylindrical in shape (see Fig. 1) and having a first drill shank shaft (34) therethrough. Wilson teaches said first upper unit (12) having a first threading on its outside surface. Schenk et al further discloses a second bottom unit (10) being cylindrical in shape (see Fig. 1) and having a second drill shank shaft (12) therethrough. Wilson teaches said second bottom unit (14) having a second corresponding threading on its inside surface (as shown in Fig. 1), wherein when said second bottom unit is screwed onto said first upper unit a root canal jig is formed. Schenk et al disclosed the jig further having a set height and allowing a shank from said drill hand set (60) to pass through said first and second drill shank shafts (34,12), such that when said drill shank (48) of said drill hand set (60) is drilled into an area, said drill shank is prevented from drilling along its entire length into the root of said affected tooth when the bottom of said jig contacts the top of the surface. As to claim 2, Schenk et al further discloses the device further comprising a locking ring (16), having a third corresponding threading (see Fig. 1) located on its inside surface, configured to screw down along said first upper unit (32) of said root canal jig down onto a top of said second bottom unit (10) of said root canal jig, so as to prevent any

relative movement between said upper first unit and said lower bottom unit of said root canal jig. Regarding claim 4, the device disclosed by Schenk et al further comprising a series of adjustment markers (44), positioned on said first upper unit (32) of said root canal jig, said adjustment markers (44) configured to denote the combined height of said root canal jig from the bottom of said second bottom unit to the top of said first upper unit. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the threadings as taught by Wilson on the inside surface of the bottom unit and on the outside of the top unit in order to provide a means for better securing the top unit and bottom unit with respect to each other.

As to claim 3, Schenk et al and Wilson teach the claimed invention except for the device further comprising a primary marker, positioned on said second bottom unit of said root canal jig, said primary marker configured to display the height of said second bottom unit. It would have been an obvious matter of design choice to put a label or marking on the bottom unit, since applicant has not disclosed that adding marking solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well without any marking on the bottom unit.

2) Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown. Brown discloses the claimed invention except for the jig ring being a horseshoe ring and being made of a nickel-titanium alloy. To claim 7, it would have been an obvious matter of design choice to make the jig ring of any shape including that of a horseshoe, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art.

With regards to claim 8, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the device of a nickel-titanium alloy, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

3) Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Schaffner (USPN 4,212,639). Brown discloses the claimed invention except for housing comprising a height dial having a plurality of incremented height measurements thereon. Schaffner teaches a plurality of incremented height measurements (4) marked on the housing of a device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the markings thereon as taught by Schaffner onto the housing disclosed by Brown so that the height is visible to the user during use.

4) Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Schaffner as applied to claim 12 above, and in further view of Christianson et al (USPN 4,019,827). Brown and Schaffner teach the claimed invention except for the stem having a spring flange and the housing having a biasing spring. Christianson et al teach a spring flange (20) and the housing having a biasing spring (32), wherein the biasing spring acts on the spring flange of the stem, forcing the stem into the housing, in a direction away from the drilling end of the drill hand set. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the spring flange and biasing spring as taught by Christianson et al into the device taught by Brown and Schaffner in order to provide means for

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automatically pressing the stem into the housing when the drill hand set is applied to a surface for drilling.

5) Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Schultz (USPN 6,585,143). Brown discloses the claimed invention except for the housing comprising a height screw associated with a plurality of incremented height measurements marked on the stem and viewable through a height window in the housing. Schultz teaches as best shown in Figs. 1 and 2, a housing (18) comprising a height screw (20) associated with a plurality of incremented height measurements (1) marked on the stem and viewable through a height window (15) in the housing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the height screw and height window as taught by Schultz in order to provide increased visibility of the depth of the stem during use.

6) Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of Schultz as applied to claim 16 above and in further view of Christianson et al. Brown and Schultz teach the claimed invention except for the stem having a spring flange and the housing having a biasing spring. Christianson et al teach a spring flange (20) and the housing having a biasing spring (32), wherein the biasing spring acts on the spring flange of the stem, forcing the stem into the housing, in a direction away from the drilling end of the drill hand set. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the spring flange and biasing spring as taught by Christianson et al into the device taught by Brown and Schultz in order to provide means for automatically pressing the stem into the housing when the drill hand set is applied to a surface for drilling.



***Allowable Subject Matter***

Claims 5,9-11,14-15, and 18-19 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Candice C. Stokes whose telephone number is (571) 272-4714. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Candice C. Stokes

  
Cary E. O'Connor  
Primary Examiner